

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-5, 7, 9, and 11-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,374,707 B1 to Browning ("Browning"). Similarly, the Office action rejected claims 1-5, 7, 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Design Patent No. 376,520 to Morin ("Morin"). Further, the Office action rejected claims 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Morin in view of Browning. Further yet, the Office action rejected claim 10 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim that which the applicants regard as their invention. In addition to these claim rejections, the Office action objected to claim 6 and two sections of the specifications for typographical errors. The Office action indicated that claims 6, 8, and 10 contain patentable subject matter would be allowable if these claims were to be rewritten in independent form to include the recitations of the claim from which each claim depends as well as any intervening claims. Applicants thank the Examiner for this indication of allowable subject matter. Applicants have amended claim 6 and the specification correct the typographical errors. Regarding the claim rejections, applicants respectfully disagree.

By present amendment, claims 1, 6, 9 and 12 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the

claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a tool comprising a drive shaft with a longitudinal axis and a socket attached to the drive shaft. The socket portion of the tool is especially well suited to engage a screw hook and to securely engage the contours of the hook portion of a screw hook. As such, the socket includes a cavity having a substantially rectangular opening defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall is opposite the opening. In this manner, the cavity is shaped to engage the screw hook on two parallel runs on the hook portion. That is, two forces are applied to the screw hook in equal and opposite directions at an angle different from the direction of the longitudinal axis of the shaft. This is because the opening is at a non-zero angle (*i.e.*, the normal vector emanating directly out of the opening). Thus, the screw hook is prevented (by the equal and opposite forces) from rotating away from the longitudinal axis of the shaft. Because of the non-zero angle in which the opening of the cavity is aligned with respect to the longitudinal axis of the shaft, the engaged screw hook may be anchored to a wall or ceiling with relative ease because the screw hook will not rotate away from the longitudinal axis of the tool.

The tool of the present invention is unique, because screw hooks typically have straight parallel runs in the hook portion of the screw hook, the cavity that engages the screw hook is able to apply forces in directions that are not perpendicular (like any typical socket that engages a bolt or a nut) to the longitudinal axis of the screw hook. As such, the screw hook will not rotate when engaged with the screw hook socket tool.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Rejections under §102(b) by Browning

Turning to the claims, amended claim 1 recites a tool, comprising a drive shaft having a longitudinal axis and having a first end and a second opposite end; and a cavity attached to the first end of the drive shaft, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening.

The Office action rejected claim 1 as being anticipated by Browning. More specifically, the Office action contends that Browning discloses a tool, comprising: a drive shaft having a longitudinal axis and having a first end and a second opposite end and a cavity attached to the first end of the drive shaft, the cavity having a substantially rectangular opening with a first side length longer than a

second side length, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening. The Office action, however, fails to cite any specific section of Browning that discloses these recitations, thus, applicants now present arguments as best as possible without the benefit of specific cites the teachings of Browning. In any case, applicants respectfully disagree with these rejections.

Browning teaches, generally, a wrench that is operable to engage an eyebolt. More specifically, as shown in FIGs. 1 and 2, the wrench includes an eye bolt cup that has walls that define a cavity that is oval in a horizontal cross-section and that is semi-circular in a vertical cross-section. See column 2, lines 43-47 and FIGs. 4 and 5 of Browning. Furthermore, the opening of the cup has a normal that is exactly parallel with the longitudinal axis of the shaft so that when engaged, any force exerted vertically on the shaft is transferred directly and in a parallel manner to the eye bolt. See FIG. 2 and column 2, line 60 to column 3, line 5 of Browning. Thus, the angle of the longitudinal axis of the shaft of the wrench, the normal of the opening of the cup and the longitudinal axis of the shaft of the eye bolt are at all times parallel throughout the use of the eye bolt wrench of Browning and must remain so. Because the interior of the cup of the eye bolt wrench is semi-circular, it intuitively follows that any rotation of the eye bolt beyond the core longitudinal axis will result in slippage as the eye bolt rotates within the cup.

In contrast, claim 1 recites a cavity attached to the first end of the drive shaft, the opening having a normal in a direction that is at a non-zero angle with

respect to the longitudinal axis of the shaft. That is, unlike the eye bolt wrench of Browning, the cavity at the end of the shaft is at an angle such that the parallel contours of a screw hook (which is not an eye bolt) may be engaged by parallel sides in the interior of the cavity. As such, the shaft of the screw hook is prevented from rotating away from the longitudinal axis of the shaft of the tool, because the parallel sides in the interior of the cavity engage the parallel runs of the screw hook. As a result, the screw hook is prevented from rotating within the cavity. Browning cannot possibly be construed to teach a cavity having an opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft as recited in claim 1.

Furthermore, claim 1 recites the cavity is further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening. As discussed above, Browning merely teaches a semi-circular cup. A semi-circular cup, by definition, cannot have parallel side walls. Therefore, Browning cannot possibly teach a cavity defined by a pair of parallel side walls let alone a cavity defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening as recited in claim 1.

Applicants submit that, for at least the foregoing reasons, claim 1 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 2-8, by similar analysis, are allowable. Each of these claims depends either directly or indirectly

from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Browning fails to disclose the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 4 recites the tool of claim 1, further comprising a handle attached to the second end of the drive shaft and operable to be engaged by a hand. Nowhere in the teachings of Browning can there be found any teaching of a handle of any kind, let alone a handle attached to the second end of the drive shaft and operable to be engaged by a hand. Applicants submit that claim 4 is allowable for at least this additional reason.

Turning to the next independent claim, amended claim 9 recites a tool, comprising a drive shaft having a longitudinal axis and having a first end and a second opposite end and an engaging enclosure having an opening wherein the normal of the opening is in a direction that is at a non-zero angle with respect to the longitudinal axis of the drive shaft, the engaging enclosure attached to the first end of the drive shaft and operable to engage an object wherein the engaging enclosure applies substantially equal and opposite forces to the object at an angle other than perpendicular to the longitudinal axis when the object is rotated about an axis perpendicular to the longitudinal axis.

The Office action rejected claim 9 as being anticipated by Browning. More specifically, the Office action contends that Browning discloses a tool, comprising a drive shaft having a longitudinal axis and having a first end and a second opposite

end and an engaging enclosure attached to the first end of the drive shaft and operable to engage an object wherein the engaging enclosure applies a force to the object at an angle other than perpendicular to the longitudinal axis if the object is rotated about an axis perpendicular to the longitudinal axis. Again, the Office action fails to cite any specific section of Browning that discloses these recitations, thus applicants now present arguments as best as possible without the benefit of specific cites the teachings of Browning. In any case, applicants respectfully disagree with these rejections.

As was discussed above with respect to claim 1, Browning teaches a semi-circular cup that engages an eye bolt such that the angle of the longitudinal axis of the shaft of the wrench, the normal of the opening of the cup, and the longitudinal axis of the shaft of the eye bolt are at all times parallel throughout the use of the eye bolt wrench of Browning. Because the interior of the cup of the eye bolt wrench is semi-circular, it intuitively follows that any rotation of the eye bolt beyond the core longitudinal axis will result in slippage as the eye bolt rotates within the cup. Therefore, Browning cannot possibly be construed to teach an engaging enclosure having an opening wherein the normal of the opening is in a direction that is at a non-zero angle with respect to the longitudinal axis of the drive shaft, the engaging enclosure attached to the first end of the drive shaft and operable to engage an object wherein the engaging enclosure applies substantially equal and opposite forces to the object at an angle other than perpendicular to the longitudinal axis as recited in claim 9. For at least these reasons, applicants submit that claim 9 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 10 and 11, by similar analysis, are allowable. Each of these claims depends directly from claim 9 and consequently includes the recitations of independent claim 9. As discussed above, Browning fails to disclose the recitations of claim 9 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 9 noted above, each of these dependent claims includes additional patentable elements.

Turning to the last independent claim, amended claim 12 recites a method, comprising engaging an object with a tool having a cavity attached to a first end of a drive shaft having a longitudinal axis, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening and rotating the object about the longitudinal axis.

The Office action rejected claim 12 as being anticipated by Browning. More specifically, the Office action contends that Browning discloses a method, comprising engaging an object with a tool having a cavity attached to a first end of a drive shaft having a longitudinal axis, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-

shaped wall opposite the opening and rotating the object about the longitudinal axis. Again, the Office action fails to cite any specific section of Browning that discloses these recitations, thus applicants now present arguments as best as possible without the benefit of specific cites the teachings of Browning. In any case, applicants respectfully disagree with these rejections.

As was discussed above with respect to claim 1, Browning teaches a semi-circular cup that engages an eye bolt such that the angle of the longitudinal axis of the shaft of the wrench, the normal of the opening of the cup, and the longitudinal axis of the shaft of the eye bolt are at all times parallel throughout the use of the eye bolt wrench of Browning. Because the interior of the cup of the eye bolt wrench is semi-circular, it intuitively follows that any rotation of the eye bolt beyond the core longitudinal axis will result in slippage as the eye bolt rotates within the cup. Therefore, Browning cannot possibly be construed to teach engaging an object with a tool having a cavity attached to a first end of a drive shaft having a longitudinal axis, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening as recited in claim 12. For at least these reasons, applicants submit that claim 12 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 13-15, by similar analysis, are allowable. Each of these claims depends directly from claim 12 and

consequently includes the recitations of independent claim 12. As discussed above, Browning fails to disclose the recitations of claim 12 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 12 noted above, each of these dependent claims includes additional patentable elements.

Rejections under §102(b) by Morin

As was discussed above, amended claim 1 recites a tool, comprising a drive shaft having a longitudinal axis and having a first end and a second opposite end; and a cavity attached to the first end of the drive shaft, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening.

Again, the Office action rejected claim 1 as being anticipated by Morin without any specific references to any section of Morin. As was discussed above with respect to the rejection by Browning, Morin simply shows a tool having a cavity attached to a shaft wherein the cavity has an opening that has a normal in a direction that is exactly parallel to the longitudinal axis of the shaft. Furthermore, absent any written description due to the nature of a design patent (Morin), one cannot possibly construe the use of the tool depicted in Morin. That is, there is no disclosure in Morin, whatsoever, that shows any cognizance of a screw hook, an

eye bolt, or even any object under the sun with which the tool is intended to be engaged. While Morin shows different perspective drawings of a tool having some similar characteristics to the present invention, Morin cannot possibly be construed to teach a cavity attached to the first end of the drive shaft, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft as recited in claim 1. For at least these reasons, applicants submit that claim 1 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 2-8, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Browning fails to disclose the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 4 recites the tool of claim 1, further comprising a handle attached to the second end of the drive shaft and operable to be engaged by a hand. Nowhere in the teachings of Morin can there be found any teaching of a handle of any kind, let alone a handle attached to the second end of the drive shaft and operable to be engaged by a hand. Applicants submit that claim 4 is allowable for at least this additional reason.

Turning, again, to the next independent claim, amended claim 9 recites a tool, comprising a drive shaft having a longitudinal axis and having a first end and a

second opposite end; and an engaging enclosure having an opening wherein the normal of the opening is in a direction that is at a non-zero angle with respect to the longitudinal axis of the drive shaft, the engaging enclosure attached to the first end of the drive shaft and operable to engage an object wherein the engaging enclosure applies substantially equal and opposite forces to the object at an angle other than perpendicular to the longitudinal axis when the object is rotated about an axis perpendicular to the longitudinal axis.

As before, Morin simply shows a tool having a cavity attached to a shaft wherein the cavity has an opening that has a normal in a direction that is exactly parallel to the longitudinal axis of the shaft. Therefore, Morin cannot possibly be construed to teach an engaging enclosure having an opening wherein the normal of the opening is in a direction that is at a non-zero angle with respect to the longitudinal axis of the drive shaft, the engaging enclosure attached to the first end of the drive shaft and operable to engage an object wherein the engaging enclosure applies substantially equal and opposite forces to the object at an angle other than perpendicular to the longitudinal axis as recited in claim 9. For at least these reasons, applicants submit that claim 9 is allowable over the prior art of record.

Again, applicants respectfully submit that dependent claims 10 and 11, by similar analysis, are allowable. Each of these claims depends directly from claim 9 and consequently includes the recitations of independent claim 9. As discussed above, Morin fails to disclose the recitations of claim 9 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim

9 noted above, each of these dependent claims includes additional patentable elements.

Turning, again, to the last independent claim, amended claim 12 recites a method, comprising engaging an object with a tool having a cavity attached to a first end of a drive shaft having a longitudinal axis, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening and a curved portion of the U-shaped wall opposite the opening and rotating the object about the longitudinal axis.

As before, Morin simply shows a tool having a cavity attached to a shaft wherein the cavity has an opening that has a normal in a direction that is exactly parallel to the longitudinal axis of the shaft. Therefore, Morin cannot possibly be construed to teach engaging an object with a tool having a cavity attached to a first end of a drive shaft having a longitudinal axis, the cavity having a substantially rectangular opening with a first side length longer than a second side length, the opening having a normal in a direction that is at a non-zero angle with respect to the longitudinal axis of the shaft, the cavity further defined by a pair of parallel side walls of the first side length and a U-shaped wall having two parallel walls adjacent to the opening as recited in claim 12. For at least these reasons, applicants submit that claim 12 is allowable over the prior art of record.

Rejections under §103(a)

The Office action rejected claim 13-15 as being unpatentable over Morin in view in Browning. Applicants respectfully submit that dependent claims 13-15 by similar analysis to the analysis discussed above with respect to claim 12, are allowable. Each of these claims depends directly from claim 1 and consequently includes the recitations of independent claim 12. As discussed above, both Morin and Browning fail to disclose the recitations of claim 12 and, therefore, these claims are also allowable over the prior art of record. In addition to the recitations of claim 12 noted above, each of these dependent claims includes additional patentable elements which render these claims patentable over any permissible combination of the prior art of record including any permissible combination of Morin and Browning.

For example, claim 14 recites the method of claim 12 further comprising providing the rotating by means of a handle. Nowhere in the teachings of Browning or in Morin can there be found any teaching of a handle of any kind, let alone a handle that provides a rotating means. Applicants submit that claim 14 is allowable for at least this additional reason.

Applicants submit that the Office action has failed to show any motivation to combine the teaching of Morin with the teachings of Browning. Bear in mind that, as a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such

impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-15 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 822-3668.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K. D. Jablonski', is written over a horizontal line.

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In re Application of Tassano et al.
Serial No. 10/731,609



CERTIFICATE OF MAILING

I hereby certify that this Amendment, along with Transmittal are being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Date: 9/8/04


Kevin D. Jablonski

1005-1-3 Amendment